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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77844736
Applicant	Apple Inc.
Applied for Mark	OPENCL
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of		:
Apple Inc.		:
		:
Mark:	OPENCL and Design	:
Serial No.	77/844,736	:
Filing Date:	October 8, 2009	:

APPLICANT'S REPLY BRIEF

Applicant Apple Inc.[1] submits this reply brief in support of its application to register the OPENCL Logo and in response to the Examining Attorney's Sept. 22, 2015 appeal brief ("EA Br.").

The Examining Attorney argues that the OPENCL Logo should be refused on three different grounds, namely, that:

1. OpenCL is an "industry standard" and therefore refers to a method or process, and does not function as a trademark;
2. OpenCL is a certification mark and not a trademark; and
3. Applicant's specimen does not show trademark use.

The first and third grounds for refusal were raised during the examination of the Statement of Use. The second ground is entirely new and was never raised in the February 17, 2014 office action or the September 10, 2014 final refusal; it appears for the first time in the Examining Attorney's Appeal Brief, which was drafted by a different examining attorney than the examining attorney responsible for the initial office action and the final refusal. Apple has not had the opportunity to respond to this issue during prosecution or to submit any evidence on this issue. Accordingly, Apple objects to the Examining Attorney's untimely raising of a new issue six years after the filing of the application. *See In re Moore Business Forms Inc.*, 24 USPQ2d 1638, 1638 n.2 (TTAB 1992) (refusing to consider new ground raised

[1] Unless otherwise defined, capitalized terms in this brief are defined in Applicant's Appeal Brief, dated July 14, 2015 ("Apple Br.").

for the first time in examining attorney's brief and deciding case on the basis of the original ground of refusal); *In re ZD, Inc.*, 1999 WL 597338 (TTAB 1999) (refusing to consider new ground for refusal raised by examining attorney because "it is inappropriate to raise a new ground of refusal for the first time in an appeal brief").

This new ground is also inappropriate because this is an appeal of the refusal of Apple's Statement of Use specimen, yet the Examining Attorney's certification mark refusal makes no reference to any aspect of Apple's specimen, and is based instead on evidence in the record.

Apple therefore respectfully requests that the Board disregard the second ground for refusal.

As for the first ground for refusal, it is essentially identical to the ground raised, and appealed to the Board, during the initial examination of this application. In the prior ex parte appeal on this application, the title of the first claim in the Examining Attorney's Appeal Brief (Dkt. 17) was as follows:

> "The Term OPENCL is Merely Descriptive Because it Identifies the Common Name of an Industry Standard."

Now, the first claim in the Examining Attorney's current Appeal Brief is also a refusal based on the contention that OPENCL is an "industry standard":

> "A Term Recognized as an Industry Standard Process Cannot Also Function as a Trademark to Identify the Source of One Party's Goods Implementing the Standard."

As a matter of substance the same application has been refused twice on the same grounds. The assertion that OPENCL fails to function as a mark because it is an "industry standard" could have been made as part of the refusal on the initial examination, but was not. Section 1109.08 of the *Trademark Manual of Examining Procedure* provides that during examination of the Statement of Use, "[t]he examining attorney should not make a requirement or refusal concerning matters that could or should have been raised during initial examination, unless the failure to do so in initial examination constitutes a 'clear error'." The omission of a fails-to-function refusal at the Statement of Use stage was not clear error, because the "industry standard" objection had already been asserted on initial examination, and rejected on appeal. Indeed, although Apple did not submit a specimen of use until after the Notice of

Allowance, its November 26, 2010 office action response included five pages from Apple's website displaying the OpenCL Logo and describing the standard. The use to which the Examining Attorney is now objecting was present in those web pages. This is not a situation in which the Examining Attorney discovered anything new when a specimen of use was finally submitted.

The Examining Attorney's Appeal Brief did not respond to Apple's contentions on this point, and provides no justification for the new refusal. Apple respectfully requests that the Board reverse the refusal on the basis that the Examining Attorney should not have asserted a fails-to-function refusal on the Statement of Use.

1. OPENCL is Recognized and Functions as Apple's Trademark

As to the merits of the first claim, the Examining Attorney ignores the basic fact that OpenCL software has a single source – Apple – and that software developers identify Apple as the source. The fact that Apple has chosen to make OpenCL available to the industry via licensing does not diminish the fact that the industry views Apple as the source. To the contrary, software developers who want to use this development framework understand that they are licensing development tools that Apple created. Consistent with this, no one in the industry opposed Apple's registration of OPENCL or the OPENCL Logo – the only objection comes from the Examining Attorney.

As a substantive matter, the Examining Attorney confuses industry-wide standards that are adopted by government organizations and industry trade organizations with software development tools that individual companies create and allow others to use. Each functions as a "standard" in the broadest sense, but the terminology used to identify the latter still functions as a trademark.

The Examining Attorney summarizes the basis for refusal as follows:

> OpenCL is recognized in the relevant industry as an open, non-proprietary, *industry standard* computing language and API. As an industry standard, consumers would recognize OpenCL, as used by Applicant, as a *method* or *process* used throughout the industry for parallel programming on CPSs and GPUs.

(EA Br. at 8 (emphasis added)). However, the Examining Attorney has failed to meet his burden of showing that the OPENCL Logo does not function as a trademark. Specifically, this refusal fails to:

- define the "relevant industry";
- show that OpenCL is "a *method* or *process* used throughout the [undefined] industry";
- explain how a technical framework created by Apple and offered only under license could be "non-proprietary"; and
- address the extensive evidence submitted by Apple that OpenCL is in fact recognized as Apple's trademark – and, of course, that Apple's existing registration of OPENCL creates a presumption that it is Apple's mark.

The Examining Attorney bears the burden of showing in clear, specific terms that the computer development community specifically uses OpenCL as something other than Apple's trademark, but there is no evidence in the record of non-trademark use – Apple's evidence in fact demonstrates quite the opposite. Instead the refusal cites as authority (a) single-sentence definitions of the words "standard" or "industry standard" from various dictionaries, and (b) references to OpenCL as an "industry standard" in several excerpts of articles found in a LexisNexis search.

The Examining Attorney confuses (1) an industry-wide standard with (2) an industry standard which is one of several that a company might opt to adopt. OpenCL is the latter. In the case of an industry-wide standard, a government authority imposes the standard on all producers, an industry-wide organization agrees on a standard for the entire industry, or every producer as a matter of practicality adopts and uses the same standard. The examining attorney argues that when everyone adopts the same standard, it's not an indicator of source. However, that is not the circumstance with OpenCL -- it is one of a number of standards that developers can use for parallel computing. Because it was created by Apple and is implemented via license, it does function as an indicator of source for Apple's OpenCL software.

The Examining Attorney's Definitions Do Not Apply to OpenCL

The Examining Attorney cites the following definitions of "industry standard":

- "Generally accepted *requirements* followed by the members of an industry." (EA Br. at 5);

- "Established as being the *required* standard or norm in a particular area of business." (*Id.*); and
- "A voluntary industry developed document that establishes *requirements* for products, practices, or operations." (*Id.*)

Although the Examining Attorney italicizes the word *"requirements"* or *"required"* in each definition, he provides no proof that anything about OpenCL is mandatory. To the contrary, none of the foregoing definitions applies to OpenCL, because Open CL is not a set of "requirements followed by the members of an industry", "the required standard or norm" in the computer industry, or a "voluntary industry developed document that establishes requirements for products, practices, or operations."

Similarly, the Examining Attorney cites four definitions that he asserts refer to a non-proprietary standard, but these definitions do not support the premise of the refusal:

- "A specification for hardware or software that is either widely used and accepted (de facto) or is sanctioned by standards organization (de jure)." (*Id.*)
- "Standards … may be de facto standards for various communities or officially recognized national or international standards." (*Id.*)
- "A standard is a document that contains technical specifications or other criteria to be used consistently as a rule, guideline or definition of characteristics to ensure that materials, products, processes, personal services are competent and or fit for their intended purposes." (*Id.*)
- "Standards may be set by official standards organizations, or they may be unofficial standards that are established by common use." (*Id.*)

These definitions also do not apply to OpenCL because:

- OpenCL is not de jure sanctioned by an official standards organization or officially recognized national or international standards.
- OpenCL is not a sole de facto standard – other parallel computing standards from other sources are also available to the industry.

In fact, there is no single "industry standard" for parallel computing. As the evidence relied on by the Examining Attorney makes clear, a number of other standards are available, including but not limited to MPI, OpenMP and CUDA. *See* EA Br. n. 14-15 (Aug. 16, 2011 Reconsideration Letter at 20 (identifying MPI and OpenMP as other API and programming platforms for parallel computing)); EA Br. at 6-7 (Aug. 16, 2011 Reconsideration Letter Article 60 of 119 (comparing OpenCL to CUDA parallel

computing framework)); *see also* Aug. 16, 2011 Reconsideration Letter, Article 44 of 119 (identifying CUDA, "a parallel computing architecture available to software developers for a number of applications").

Unlike an official standards organization, Khronos has no governmental authority to require compliance with standards that are developed and endorsed by its member companies.

In mistakenly assuming that "standard" is a one-size-fits-all definition, the Examining Attorney ignores the authority cited in Apple's brief on the meaning of "open standard":

> There is no single definition and interpretations vary with usage. The terms 'open' and 'standard' have a wide range of meanings associated with their usage. There are a number of different definitions of open standards which emphasize different aspects of openness, including … the ownership of rights in the standard… Many specifications that are sometimes referred to as standards are proprietary and only available under restrictive contract terms (if they can be obtained at all) from the organization that owns the copyright on the specification." (http://en.wikipedia.org/wiki/Open_standard#Programming_languages).

(Apple Br. at 9.)

Apple's OpenCL is a computing framework initiated and developed by a single company, and offered via license to other companies that wish to use it. There is no government or industry standards authority that has imposed it on the software development community, nor is it the de fact standard of that community.

Third Party References to OpenCL Recognize Apple's Rights or Are Irrelevant

The Examining Attorney has selectively quoted a handful of web pages and LexisNexis article excerpts that were attached to Office Actions, dated August 16, 2011 and February 17, 2014, as evidence that OpenCL is an "industry standard" computing language (EA Br. at 5-7.). Contrary to the Examining Attorney's suggestion, however, these materials –when taken in context – reinforce that OpenCL is recognized as Apple's trademark and that the software developer community understands OpenCL to be one of many parallel computing platform options for use by developers, rather than a required "industry standard":

- The first sentence of Acceleware's May 11, 2011 press release (EA Br. n.13; Aug. 16, 2011 Reconsideration Letter at 11), states that "AMD … today announced a collaboration with Acceleware whereby the companies will deliver professional training programs to help developers learn how to create applications that comply with OpenCL™ standards." Acceleware's use of the "TM" legend acknowledges Apple's rights in the mark and negates the ambiguous statement appearing later in the press release that OpenCL is a "non-proprietary industry standard."

- The community.topcoder.com web page (EA Br. n. 14-15; Aug. 16, 2011 Reconsideration Letter at 19-26) is an FAQ relating to a 2011 "AMD OpenCL™ Coding Competition – GPU and CPU Technology for accelerated computing." The use of the "TM" legend acknowledges Apple's trademark rights. Moreover, the FAQ specifically explains that OpenCL is one parallel computing option, but is by no means a required "industry standard":

  > **10. How does OpenCL compare to other APIs and programming platforms for parallel computing, such as OpenMP and MPI? Which one should I use?** OpenCL is designed to target parallelism within a single system and provide portability to multiple different types of devices (GPUs, multi-core CPUs, etc.). OpenMP targets multi-core CPUs and SMP systems. MPI is a message passing protocol most often used for communication between nodes; it is a popular parallel programming model for clusters of machines. Each programming model has its advantages. It is anticipated that developers mix APIs, for example programming a cluster of machines with GPUs with MPI and OpenCL.

- The http://news.softpedia.com/ web page (EA Br. n. 16; Feb. 17, 2014 Office Action at 20) is a December 3, 2009 announcement of AMD and SiSoftware's development of an OpenCL "benchmark suite" solution for "measuring OpenCL-based configurations." The language quoted in the Examining Attorney's Appeal Brief states that OpenCL is "the most widely adopted industry standard" for parallel data processing. The quoted language acknowledges that there are other, less widely adopted, parallel data processing "industry standards", and the announcement does not state or suggest that OpenCL is an industry standard that must be adhered to by software developers.

- The www.genomeweb.com web page (EA Br. n. 17; Aug. 16, 2011 Reconsideration Letter at 27-29) is a March 12, 2010 article suggesting that users of the Python programming language consider using the OpenCL platform, which the Khronos group was promoting as a "standard" parallel computing platform – it does not state that the OpenCL platform is a required "industry standard." Furthermore, the article acknowledges that OpenCL is but one example of a "standard" API: "'From an Independent Software Developer standpoint, OpenCL is the gateway to hybrid (CPU/GPU) computing,' writes Eadlie. 'As anyone with scar tissue in the HPC industry can tell you, investing resources and time into non-standard Applications Programming Interfaces is a risky business. MPI was developed for similar reasons, (i.e. programmers did not want to recode every time a new parallel computer architecture hit the server room).'"

With respect to the article excerpts turned up in a LexisNexis search that were attached to the August 16, 2011 Reconsideration Letter, from which the Examining Attorney has cherry-picked language

(EA Br. at 6-7), all but one of the articles cited by the Examining Attorney expressly states that the OpenCL mark belongs to Apple and/or uses OpenCL with the "TM" legend:

- Article 3 of 119 is a press release under the headline "New 3D Rendering Plug-In Leverages Open Source Bullet Physics Engine and the OpenCL(TM) Industry Standard";
- Article 56 of 119 states that "OpenCL is a trademark of Apple Inc.";
- Article 63 of 119[2] states that "MainConcept plans to leverage ATI Stream technology from AMD and OpenCL(TM) standards ….";
- Article 75 of 119 states that "OpenCL and the OpenCL logo are trademarks of Apple Inc. used by permission by Khronos."

The sole citation in the Examining Attorney's Appeal Brief of an article that does *not* use the "TM" legend with OpenCL is Article 60 of 119, which is a minimally excerpted article from "United Business Media". However, it shows that OpenCL is not an industry-wide de facto standard, comparing it with another "standard" parallel computing framework, namely, CUDA.

Trademark law is unusual, if not unique, in applying an eye-of-the-beholder test -- and in this case the beholders are sophisticated professional software developers. The Examining Attorney makes no attempt to place himself in the shoes of those in the parallel computing development community. If he did, he could not avoid recognizing that developers understand that Apple created the OpenCL computing framework, enter into licenses to use it, and identify Apple as the source. The Examining Attorney offers no rebuttal to the affidavits from those in the industry, and offers no real-world evidence or authoritative sources of his own. He has not met the burden of showing that OpenCL fails to function as a mark.

2. <u>The Specimen Meets the Trademark Office's Requirements for Software Products</u>

As Apple pointed out in its appeal brief, the specimen displays the OPENCL Logo in connection with a range of programming tools and downloadable sample code. This clearly meets the TMEP requirement that the webpage show the mark in connection with downloadable software. The examining attorney objects to the fact that the specimens don't mimic the language of the USPTO specification –

[2] The Examining Attorney's brief identifies this as "Article 61 of 119," rather than Article 63.

that they refer to "sample code" rather than "software", and that there is no reference to "computer operating software". However, the question is how the relevant class of consumers—computer programmers—understand the language, and they will understand that the term "code" is shorthand for "application programming interface computer software."

CONCLUSION

For the reasons presented above and in Apple's Appeal Brief, Apple respectfully requests that Application Serial No. 77/844,736 be approved for publication without a disclaimer of OpenCL.

Respectfully submitted,

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